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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,460	12/10/2003	Koji Shima	450137-04920	8843

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EXAMINER	
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ART UNIT	**PAPER NUMBER**
2146	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/733,460	SHIMA, KOJI	
	Examiner	Art Unit	
	Sulaiman Nooristany	2146	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14,17 and 18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14, 17-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

This Office Action is response to the Non-provisional patent application (**10/733460**) filed on **Dec 20, 2003**.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 5 - 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 5 and 8 recite "A network terminal" which is directed at a computer program and lacking its mechanism *"Please refer to claim 17"*. A computer program is non-statutory because it is not considered a process, machine, manufacture, or composition of matter, or any new and useful improvement thereof. Because the claim may be directed toward a program the claim as a whole is considered non-statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 5 -12 are rejected under 112, second paragraph as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention

In claim 5, "A network terminal" in line 1 is not clear whether this intended to be the same as machine or as software.

In claim 8, "A network terminal" line 1, is not clear whether this intended to be the

same as machine or as software.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-14, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Parker** U.S. Patent No. **US 7,099,288** in view of **Sakai** U.S. Patent No. **US 7298733.**

Regarding claims 1, 2, 5 & 8, Parker teaches wherein a network method/system, comprising:

a client terminal that requests a peer-to-peer communication **(Fig. 3, unit 28 – send access request to server)**; and

a host terminal that supports connection of the peer-to-peer communication **(peer to peer video transfer over public data network – Col.9, lines 26-27)**,

wherein said client terminal generates a request message that contains an IP address of said [[own]] client terminal **(Fig. 3, unit 28 – send request & unit 30 – get IP address)**, and said client terminal sends out the request message to said host terminal via a transmission mail server **(Fig. 1-2 unit 14 – internet "NOTE: internet contains mail-servers"; Col. 2, line 4 – mail server)**,

wherein said host terminal acquires the request message via a reception mail server **(Fig. 1-2)**, and generates a reply message containing the selected at least one IP address, and said host terminal sends the reply message to said client terminal via the transmission mail server **(response to the telephone call, the user system transfers a data call request to a server system over a public data network -- Abstract)**, and wherein said client terminal acquires the reply message via the reception mail server **(Fig. 1-2 unit 14 – internet; Col. 2, line 4 – mail server)**, and said client terminal starts a peer-to-peer communication of data transmission and reception with another terminal which is specified based on the extracted IP address **(Fig. 3, unit 38 – configure endpoints)**.

With respect to claims 1, 2, 5 & 8, Parker teaches well the invention set forth above except for the claimed "*said host terminal extracts the IP address of said client terminal from a description content of the request message, said host terminal stores the extracted IP address in a table, said host terminal selects at least one IP address from the table,*

said client terminal extracts at least one IP address of other terminals from a description content of the rely message."

Sakai teaches that it is well known to have a system wherein said host terminal extracts the IP address of said client terminal from a description content of the request message **(Fig. 5-6,9-10, 13)**, said host terminal stores the extracted IP address in a table **(Fig. 5, unit 113, 123 -- table)**, said host terminal selects at least one IP address from the table **(Fig. 5-6, 9-10, i.e.; step S7 – s2@xx.com)**, said client terminal extracts

at least one IP address of other terminals from a description content of the rely message **(Fig.5-6, 9-10, 13).**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Sakai invention for extracting IP addresses, storing them into a table and also Simple Mail Transfer Protocol (SMTP).

Motivation would be to complement the drawbacks of the known art that Parker attempts to resolve the same method such as enabling and establishing peer to peer communication between two end users via central server or any other intermediary server which acts as a proxy and it could be substituted by mail server method with no change in their respective function, and the combination would have yielded nothing more than predictable results. In additional, substituting central server by mail server is easy to remember domain name acts as intermediary between two individual users. Using a simple application program and the recipient's account name on the mail server (i.e., their e-mail address), text messages and computer files can be exchanged. The exchange, however, does not allow the users to interact in real time. Thus, there is a need for a way to allow two or more individual users to establish interactive connection sessions over the Internet without requiring overt knowledge of the other's IP address and without complicated configurations or set-ups, where Sakai means that to support for obtaining a unique and reserved IP address with the detail of a message which includes IP header information, TCP header information, content of the data, and etc while establishing communication between two end users.

Regarding claim 3, Parker and Sakai together taught the method according to claim 2, as described above. Parker further teaches wherein said generating a request message includes encrypting the IP address and including the encrypted IP address in the request message (**Systems would typically apply compression, encryption -- Col. 10, lines 65-67; The software could provide video processing, compression, and encryption -- Col. 15, lines 59-60**), and

wherein said extracting by the host terminal includes extracting the encrypted message **encryption (Col. 10, lines 65-67)** from the request message and decoding the extracted encrypted message **(Fig. 14, unit 704 -- Interface device includes DTMF decoder)**.

Sakai further teaches **(Compressed voice data per unit time to be subject to voice encoding and decoding by this voice codec is called voice frame data – Col. 80, lines 1-3).**

Regarding claim 4 & 6, Parker and Sakai together taught the method according to claim 2, as described above. Parker further teaches wherein said generating a reply message includes encrypting the at least one IP address and including the encrypted IP address in the reply message **(see above rejection)**, and wherein said selecting by the host terminal includes selecting the encrypted at least one IP address and then decoding the selected encrypted IP address (**DTMF decoder monitors the telephone connection between jacks to detect and decode any DTMF tones transmitted by telephone to the public telephone network (Col. 13, lines 31-34, Col. 14, lines 5-**

45).

Regarding claim 7, Parker and Sakai together taught the method according to claim 5, as described above. Parker further teaches wherein if unsuccessful data **(rejected data)** transmission and reception are unsuccessful with a destination terminal whose IP address is the extracted IP address, said data generator generates a message containing said IP address, and wherein said mail transmission and reception unit sends, to the terminal serving as a host said message indicative of an unsuccessful connection (**Fig. 3, units 33-34; If rejected, then user #2 generates a reject message and sends it to the central server. The central server forwards the reject message to user #1, which then terminates the data portion of the attempted communication session -- Col. 6, lines 12-16)**

Regarding claim 9, Parker and Sakai together taught the method according to claim 8, as described above. Sakai further teaches wherein said extraction processing unit extracts an encrypted IP address from a description content of the request message and decodes the encrypted IP address **(Compressed voice data per unit time to be subject to voice encoding and decoding by this voice codec is called voice frame data – Col. 80, lines 1-3)**, and

wherein said data generator encrypts the at least one IP address and has the encrypted IP address included in the reply message **(please see above rejection).**

Regarding claim 10, Parker and Sakai together taught the method according to claim 8, as descried above. Parker further teaches wherein said address storage unit restricts the number of IP addresses to be stored in the table (**IP address at which an Internet user can be reached by introducing a central server that stores information associating each registered user's IP address with identifying information well known -- Col. 2, lines 41-44**), and overwrites IP addresses previously stored **(Fig. 3, unit 23 -- update status in database)**.

Regarding claim 11, Parker and Sakai together taught the method according to claim 8, as descried above. Sakai further teaches said data generator selects from the storage content of the table recently a previously stored IP address **(Fig. 5, unit 113 – storage unit).**

Parker further teaches (**an initiation message is forwarded to the desired user using a respective IP address stored in the database -- Col. 3, lines 1-3).**

Regarding claim 12, Parker and Sakai together taught the method according to claim 8, as descried above. Parker further teaches wherein said mail transmission and reception unit acquires a message containing an IP address of a destination terminal with which the requesting terminal fails to start the data transmission and reception (**If rejected, then user #2 generates a reject message in step 33 and sends it to the central server. The central server forwards the reject message to user #1, which**

then terminates the data portion of the attempted communication session -- Col. 6, lines 12-16), via the reception mail server **(internet)**, and

said extraction processing unit extracts the failure IP address from a description content of the message, and wherein said address storage unit distinguishes the failure IP address from other IP addresses (**Fig. 3, units 33 -- reject, unit 34 -- forward denial message, unit 35 -- terminate data portion of attempted contact).**

Claim 13 has the similar limitation of claim 2; therefore, it's rejected under the same rationale as in claim 2.

Claim 14 has the similar limitation of claim 2; therefore, it's rejected under the same rationale as in claim 2.

Claim 17 has the similar limitation as those of claims 1 & 2; therefore, it's rejected under the same rationale as in claims 1 & 2.

Claim 18 has the similar limitation as those of claims 1 & 2; therefore, it's rejected under the same rationale as in claims 1 & 2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sulaiman Nooristany whose telephone number is 571-270-1929. The examiner can normally be reached on Monday Through Friday 7:30 am to 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffery Pwu can be reached on 571-272-6798. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Sulaiman Nooristany 12/11/2007**

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